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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/661,590

09/15/2003

Shunsuke Nagatani

117146

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25944 7590 01/21/2009

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ALEXANDRIA, VA 22320-4850

EXAMINER

MOTSINGER, SEAN T

ART UNIT

PAPER NUMBER

2624

MAIL DATE

DELIVERY MODE

01/21/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/661,590	<b>Applicant(s)</b> NAGATANI ET AL.	
	<b>Examiner</b> SEAN MOTSINGER	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4,6 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,6 and 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/9/2008</u> .   | 6) <input type="checkbox"/> Other: _____                          |

***Response to Applicants Arguments/Amendments***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/9/2008 has been entered.

Applicants arguments filed on 10/9/2008 have been fully considered but are moot in view of new grounds of rejection.

***Rejections Under 35 U.S.C. 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 4 and 10 is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions<sup>2</sup> indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or

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<sup>1</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

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thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. These claims perform several steps which are not limited to being performed by a computer or any device and could hence be performed with out use of another statutory category.

Claim(s) 1 and 9 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 1 defines a “system”. However, while the preamble defines a “system”, which would typically be indicative of an “apparatus”, the body of the claim lacks definite structure indicative of a physical apparatus. Furthermore, the specification indicates that the invention may be embodied as pure software (See paragraph 19). Therefore, the claim as a whole appears to be nothing more than a “system” of software elements, thus defining functional descriptive material per se.

Functional descriptive material may be statutory if it resides on a “computer-readable medium or computer-readable memory”. The claim(s) indicated above lack structure, and do not define a computer readable medium and are thus non-statutory for that reason (i.e., “When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” – Guidelines Annex IV). The scope of the presently

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claimed invention encompasses products that are not necessarily computer readable, and thus NOT able to impart any functionality of the recited program. The examiner suggests:

1. Amending the claim(s) to embody the program on “computer-readable medium” or equivalent; assuming the specification does NOT define the computer readable medium as a “signal”, “carrier wave”, or “transmission medium” which are deemed non-statutory; or
2. Adding structure to the body of the claim that would clearly define a statutory apparatus.

### ***Rejections Under 35 U.S.C. 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 6, and 9-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the specification for “a second extraction”, or the element “a first extraction performed by

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the first extraction unit and a second extraction performed by the second extraction unit...”

Claim 1, 4, 6, and 9-11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The newly amended portions “a second extraction.....” and “a first extraction performed.....” make no sense in the context of the specification. Applicant seems to be confusing the extraction and retrieval functions of the specification the examiner notes that extraction is only described with respect to text data. Retrieval matches keyword data to either voice index data, or extracted text data to identify and retrieve the data. Furthermore it is not clear what applicant means by “a same screen”. Art has been applied to the claims to the best extent possible given the unclear claims.

### ***Rejections Under 35 U.S.C. 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,249,281 issued to Chen et al. ("Chen") in view of Merrill et al US 6,789,228.

For claim 1, Chen discloses an input unit that accepts an input keyword (see figure 8 keyword search field 820).

Chen discloses an extraction unit that extracts a character string contained in static image data and a retrieval unit that matches the extracted character string with the input keyword to retrieve relevant static image data (see figure 8 the keyword is input to the keyword search field 820 and static image data with extracted character strings that match the keyword are retrieved).

Chen discloses a storage unit that stores static image data which are associated with time positions in a video data, the static image data being displayed with the video during time positions with which the static image data are associated (see figure 8 the retrieved static image data is displayed as a static image, and the static image data is displayed at a given reproduction time position associated with the video data when the user selects the static image, such as the beginning of the presentation for example. See also column 5 line 57 through column 6 line 32 and figure 5).

Chen discloses a retrieval result display unit that displays the retrieved relevant static image data (see figure 5 540), varying size of the displayed relevant static image data based on at least one of importance of the static image data and information added to the static image data (510).

Chen discloses a video display unit for displaying the retrieved static image data as a static image (see figure 8 the retrieved static image data is displayed as a static image); and according to user's operation for selecting the displayed static image, reproducing and displaying video data as an image from a reproduction time position with which the static image data is associated (the video data is displayed at a given reproduction time position associated with the static image data when the user selects the static image, such as the beginning of the presentation for example. See also figure 5 and column 5 line 57 through column 6 line 32).

Chen does not explicitly disclose extracts a character string contained in static image data by at least one of (1) extracting text data from the static image data which has the text data, and (2) performing character recognition processing on the static image data and extracting text data which is a result of the processing.

Merril discloses extracts a character string contained in static image data by at least one of (1) extracting text data from the static image data which has the text data, and (2) performing character recognition processing on the static image data and extracting text data which is a result of the processing (column6 lines 64-67). A second extraction unit that extracts the keyword input by the user from at least one of meta-data and voice index data (see figure 9 column 6 lines 64-67 column 7 lines 1-10) first extraction performed by the first extraction unit and a second extraction performed by the second extraction unit being instructed by the use on the same screen; the retrieval unit retrieving at least one of the meta data and the voice index data that include the input word (column 10 lines 30-50)



Re claim 4 Claim 4 is the method performed by the system of claim 1 and is likewise rejected

Re claim 6 claim 6 is a computer program corresponding to the method of claim 4 claim 6 is likewise rejected

Re claims 9-11 these claims depend from claims 1,4 and 6 respectively and recite, wherein the video display unit displays a time scale including a slidable plug and the user's operation for selecting at least one of the displayed relevant static image data comprises moving a slidable plug on a displayed time scale to select a slide image that is associated with the time position of the video data to be replayed which is disclosed by Chen in column 5 lines 40-50.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SEAN MOTSINGER whose telephone number is (571)270-1237. The examiner can normally be reached on 9-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on (571)272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jingge Wu/

Supervisory Patent Examiner, Art Unit 2624

Motsinger

1/15/2008